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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/622,493	07/21/2003	Hiroyuki Nagase	018995-735	4993

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EXAMINER

LE, HOA VAN

ART UNIT PAPER NUMBER

1752

DATE MAILED: 08/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/622,493

Applicant(s)

NAGASE ET AL.

Examiner

Hoa V. Le

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-5, 7-10 and 27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-10 and 27 with respect to the applied species is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-5, 7-10 and 27 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☒ Certified copies of the priority documents have been received in Application No. 10/187,605.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

This is in response to Paper filed on 02 June 2005.

I. Applicants state that claim 1 is now incorporate a portion of claim 6 being now limited to a compound containing a naphthalene structure (general formula (I-B)) only to overcome the applied reference with respect to Lam (3,615,480) since other portion of claim 6 being related to a compound containing phenylene structure (general formula (I-A)) is properly applied as originally filed.

II. In view of the limited incorporation of (I-B) portion of claim 6 into claim 1 only, a new set of references is need to applied against the newly amended claims.

III. Claim 6 as originally filed contains alternative limitations of (I-A) and (I-B). The record shows that the (I-A) portion of claim 6 was properly applied. The newly incorporated naphthalene structure (I-B) portion of the originally filed claim 6 was not required to apply to meet the claim 6 limitation.

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IV. Claims 1-5, 7-10 and 27 with respect to the applied species are rejected under 35 U.S.C. 103(a) as being unpatentable over Lam 3,615,480 considered in view of Suzuki et al (5,532,116).

Lam discloses, teaches and suggest an alkaline aqueous developer comprising potassium silicate having a ratio of silica oxide/alkali metal oxide from 2.0-1.0 and a nonionic surfactant. Please see the whole disclosure of the applied reference, especially at col.2:55, 3:26-28, 56-58, 60 and 64-66, col.5:6-8 and 34-41, col.6:6-7, Bottom of cols.5 and 6 with “DEVELOPER SOLUTIONS AND pH VALUES” having “3” in day 1, 2 and 3, “4” in day 1, 2, 3 and 4, “5” in day 1, 2, 3, 4, 5 and 7, “6” in day 1, 2, 3 and 4 and claim 6.

Lam does not specify a naphthalene containing nonionic surfactant (I-B) of the newly amended claim 1. Suzuki et al at col.20:61-66, 24:27-31 is cited to shows the known use of the claim nonionic surfactant and its amount for the advantage of obtaining stable compositions (col.2:34-49 and Table 1 on col.23).

Lam does not specify the functional language “has a conductivity...” in the instant claim 10. It has been considered but is reasonably inherent. Since the applied developers are shown to be same as those in the instant claims, they would inherently have the same or above the same functional property in the

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absence of convincing evidence to the contrary in accordance with the authority stated in *In re Schreiber*, 44 USPQ2d 1429.

Since the above references are all related to alkaline aqueous developers, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use or cite an amount of the naphthalene containing non-ionic surfactant from Suzuki et al in Lam alkaline aqueous developers for a reasonable expectation of obtaining stable compositions as disclosed, taught, suggested and obtained in Suzuki et al.

V. Applicant's arguments filed on 02 June 2005 have been fully considered but are not found to be convincing.

Since other portion of claim 6 being related to a compound containing phenylene structure (general formula (I-A)) is properly applied as originally filed, applicants are now incorporate a portion of claim 6 being now limited to a compound containing a naphthalene structure (general formula (I-B)) only to overcome the applied reference with respect to Lam (3,615,480). In view of the limited incorporation of (I-B) portion of claim 6 into claim 1 only, a new set of references is need to applied against the newly amended claims. It is known in the art to use an amount of a naphthalene structure (general formula (I-B) nonionic

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surfactant for the advantage of obtaining stable compositions. Evidence can be seen in Suzuki et al at col.20:61-66, 24:27-31, 2:34-49 and Table 1 on col.23).

Applicants urge that there are some advantages in Table 2-6 of the specification for the use of the claimed naphthalene structure (general formula (I-B) nonionic surfactant. Since Suzuki et al disclose, teach, suggest, applied and reduced to practice with a naphthalene structure (general formula (I-B) nonionic surfactant as claimed, the same or about the same advantages would also be obtained.

VI. Applicant's submission of the requirements for the joint research agreement prior art exclusion under 35 U.S.C. 103(c) only on a portion of the originally claim 6 with respect to a naphthalene structure (general formula (I-B) nonionic surfactant prompted the new ground(s) of rejection under 37 CFR 1.109(b) presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.02(l)(3). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the

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advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

VII. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoa V. Le whose telephone number is 571-272-1332. The examiner can normally be reached from 6:30 AM to 4:30 PM on Monday through Thursday and about the same time of most Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 571-272-1526.

Applicants may file a paper by (1) fax with a central facsimile receiving number 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see

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<http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hoa V. Le  
Primary Examiner  
Art Unit 1752

HVL  
17 August 2005

HOA VAN LE  
PRIMARY EXAMINER  
*Hoa Van Le*